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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

CFP-1842-1 (15722/471CIP)

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on May 3, 2006Signature *Alan D. Kamrath*Typed or printed name Alan D. Kamrath

Application Number

10/814,565

Filed

March 31, 2004

First Named Inventor

Arlo H. T. Lin

Art Unit

3749

Examiner

Alfred Basichas

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)☒ attorney or agent of record.
Registration number 28,227☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

Signature *Alan D. Kamrath*

Alan D. Kamrath

Typed or printed name

612-392-7306

Telephone number

May 3, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 3 forms are submitted.

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Attorney Docket No.15722/471CIP

Client Docket No. CFP-1842~1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re App : Arlo H. T. Lin : Confirmation No. 6890
Serial No. : 10/814,565 : Group Art Unit 3749
Filed : March 31, 2004 : Examiner Alfred Basichas
For : CIGARETTE LIGHTER WITH ALARM

Commissioner for Patents
P.O. Box 1450
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ALEXANDRIA, VA 22313-1450, ON MAY 3, 2006 (37 C.F.R. 1.8a).

APPEAL CONFERENCE REASONS

Dear Sir:

Examiner Basichas recognizes that Kuriyama does not meet the recitations of the claims as it does not recite:

- A) the message as audible; or
- B) the claimed duration (one round as recited in claims 1 and/or 13)

In attempting to fill these admitted deficiencies, Examiner Basichas contends:

Official Notice is given that audible messages are old and well known in the art. Such an arrangement has the clear and obvious benefit of providing for means of signaling. It is further noted that such a signal/message is well known to be functionally equivalent to visual signals and are easily interchangeable depending on the desired esthetic display. Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate audible signals into the invention disclosed by Kuriyama, so as to provide for the desired esthetic display.

It should be noted that all of the reasons relate solely to difference A), but do not support or show difference B). The prior art is devoid of any suggestions that the duration recited in claim 1 and/or 13 is possible or even desirable. Thus, the rejection of claims 1 and 13 and the claims

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which depend therefrom has been overcome for this reason. Favorable reconsideration is respectfully requested.

Examiner Basichas agrees that Kuriyama does not suggest the recited ears of claims 3-9 and in particular the location of the switch relative to the ears recited in claim 5. Examiner Basichas also concedes that Chen (which does teach ears) does not disclose a switch or the location of the switch relative to the ears. However, Examiner Basichas dismisses this deficiency indicating:

Furthermore, this arrangement has no specific criticality other than mere design choice based on esthetic appeal.

It is respectfully submitted that this is an improper rejection. Specifically, as to being critical, the Board of Appeals in Appeal No. 94-4450 in Application No. 07/945,247, now U.S. Patent No. 5,491,925, stated:

The limitations in appellant's claims cannot simply be dismissed "since no showing of criticality has been made" (answer, page 2 and final rejection, page 3). It is not a prerequisite to patentability that the limitation in a claim be "critical". See W. L. Gore & Associates, Inc. vs. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983).

Examining the Gore decision, the Court of Appeals for the Federal Circuit held:

Garlock 's appeal argument that the '390 claims are invalid because the recited minimum matrix tensile strengths are not "critical"' is without merit. A claim to a new product is not legally required to include critical limitations. (case citation)

Thus, even if the limitations are not critical as contended by the Examiner, does not mean the present invention is obvious over the prior art.

As to design choice, as stated by the Patent Office Board of Appeals in Ex parte Dere, 118 USPQ 541 (1957) at page 544:

It will be observed that the last sentence of the above quotation is a concession that the art contains no suggestion of having marked zones of perforation on opposing edges spaced according to the metric or English systems respectively.

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The examiner, as to this relationship, which is the very thing that yields the useful results already pointed out merely states it:

'is not seen to provide a patentable distinction, being no more than a matter of choice.'

Why he so holds he does not say and we do not see particularly since only the disclosure of the instant case makes a 'choice' available.

In view of the fact that claimed relationship has the useful advantages already enumerated, we cannot agree with this undocumented statement.

Also, as stated in the report by the Subcommittee on Quality of Examination on page 323 of the January, February and March 1990 edition of the AIPLA Bulletin:

Are the Examiners even attempting to search for what they regard as "mere matters of design choice." Federal Circuit decisions such as In re Newell, No. 89-1332 (Fed. Cir. Dec. 12, 1989) and In re Kaplan, 229 U.S.P.Q. 678, 683 (Fed. Cir. 1986), show that the Federal Circuit has recognized the problem and will insist on the citation of relevant art. A rejection based on "mere design choice" should be supported by the prior art.

Particularly, as set forth in In re Kaplan, 229 U.S.P.Q. 678, 683 (Fed. Cir. 1986):

In the later case [a mere variation of that invention which would have been obvious to those of ordinary skill in the relevant art], there must be some clear evidence to establish why the variation would have been obvious which can properly qualify as "prior art." Even if obviousness of the variation is predicated on the level of skill in the art, prior art evidence is needed to show what that level of skill was. (Bracketed material and emphasis added.)

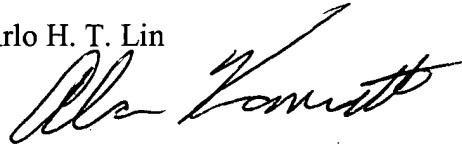
The failure of the Examiner to in any way support that any other "design choice" is suggested by the prior art is a clear indication that the present invention is not obvious in view of the prior art. Furthermore, where is it suggested that the switch location is desirable or a factor in "design choices" to create an "esthetic appeal"? It is respectfully submitted that the rejection of claim 5

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has been overcome for this separate and independent reasons. Favorable reconsideration is respectfully requested.

Respectfully submitted,

Arlo H. T. Lin

A handwritten signature in dark ink, appearing to read 'Alan D. Kamrath', written over the typed name.

Dated: May 3, 2006.

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